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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,617	08/17/2000	David Platt	TIVO0043	6921

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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/642,617

Applicant(s)

PLATT, DAVID

Examiner

Pramila Parthasarathy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the communication filed on May 18, 2005.

Claims 1 – 28 were previously presented. No new claims were added. Claims 1 and 14 were amended.

Response to Arguments

2. Applicant's arguments filed on May 18, 2005, have been fully considered but they are not persuasive for the following reasons:

3. Regarding independent Claims 1 and 14, Applicant argues that Vicard (U.S. Patent Number 5,764,761) does not teach or disclose "a system that generates a response value using a combination of a lock value and said challenge value at said second party".

4. This argument is not persuasive. Vicard discloses a first device (Chip) that is provided with a lock circuitry that controls operational enablement of a functional block of the chip. The lock circuitry inhibits operation of the device until the response value of the second device is matched with the challenge value and lock value. Vicard further discloses that in order to ascertain whether an input chip-key is the correct one to unlock the particular (first) device, the lock circuitry further comprises a one-way

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function block that subjects the chip-key output (challenge value) to the one-way function block to form the chip-key signature (response value) held in register. This is compared with the signature (response value) stored in register; if a match is found, the access is provided between the first device and the second device (validates the response value).

5. Applicant clearly has failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts. Therefore, the examiner respectfully asserts that Vicar does teach or suggest the subject matter broadly recited in independent claims 1 and 14. Dependent claims 2 – 13 and 15 – 28 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action.

Accordingly, the rejection for the pending Claims 1 – 28 is respectfully maintained.

6. Examiner suggests applicant to amend the claims in a manner to distinct applicant's invention with prior art with **attention** given to the instant application specification page 11 lines 8 – 20 and page 13 line 24 – Page 14 line 24.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1- 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vicard (U.S. Patent Number 5,764,761).

8. Regarding Claim 1, Vicard teaches
generating a challenge value at said first party (Column 3 lines 8 – 20);
transmitting said challenge to said second party (Column 3 lines 8 – 20);
generating a response value using a combination of a lock value at said second party, wherein said lock value indicates a desired access mode (Column 3 lines 21 – 54);
transmitting said response value to said first party (Column 3 lines 40 – 55); and
validating said response value by said first party (Column 3 line 40 – Column 4 line 2).

9. Regarding Claim 14, Vicard teaches
means for generating a challenge value at said first party (Column 3 lines 8 – 20);
means for transmitting said challenge to said second party (Column 3 lines 8 – 20);

means for generating a response value using a combination of a lock value at said second party; wherein said lock value indicates a desired access mode (Column 3 lines 21 – 54);

means for transmitting said response value to said first party (Column 3 lines 40 – 55); and

means for validating said response value by said first party (Column 3 line 40 – Column 4 line 2).

10. Claims 2 and 15 are rejected as applied above in rejecting claims 1 and 14.

Furthermore, Vicard teaches and describes said first party is a disk drive and said second party is a host computer (admitted prior art, instant application Fig. 1; Column 3 lines 1 – 7 and Column 6 lines 5 – 57).

11. Claims 3 and 16 are rejected as applied above in rejecting claims 1 and 14.

Furthermore, Vicard teaches and describes said disk drive is locked when not accessed (admitted prior art, instant application Fig. 1 and Column 2 lines 57 – 65).

12. Claims 4 and 17 are rejected as applied above in rejecting claims 1 and 14.

Furthermore, Vicard teaches and describes using 512 bits for said challenge value and using 512 bits for said lock value (Column 4 lines 25 – 51).

13. Claims 5 and 18 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes randomly generating said challenge value (admitted prior art, instant application Fig. 1 and Column 3 lines 1 – 36).

14. Claims 6 and 19 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes using a disk drive controller to generate said challenge value (admitted prior art, instant application Fig. 1; Column 3 lines 1 – 7 and Column 6 lines 5 – 57).

15. Claims 7 and 20 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes using an exclusive OR to combine said challenge value and lock value (Column 3 lines 21 – 36).

16. Claims 8 and 21 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes using 160 bits for said response value (Column 3 lines 21 – 36).

17. Claims 9 and 22 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes said step of generating a said response value further includes the step of using a cryptography circuit to generate said response value (admitted prior art, instant application Page 3 lines 24 – 30 and Column 2 line 57 – Column 3 line 20).

18. Claims 28 and 27 are rejected as applied above in rejecting claims 1 and 14. Furthermore, Vicard teaches and describes said step of validating said response value further includes unlocking the disk drive in accordance with the desired access mode indicated by the lock value if the response value is valid (admitted prior art, instant application Fig. 1 and Column 5 line 29 – Column 6 line 31).

19. Claims 10 and 23 are rejected as applied above in rejecting claims 9 and 22. Furthermore, Vicard teaches and describes the step of using an algorithm to generate said response value (Column 3 lines 21 – 36).

20. Claims 11 and 24 are rejected as applied above in rejecting claims 6 and 14. Furthermore, Vicard teaches and describes a secure hash algorithm to generate said response value (Column 3 lines 40 – 54).

21. Claims 12 and 25 are rejected as applied above in rejecting claims 11 and 19. Furthermore, Vicard teaches and describes

said disk drive controller receives the challenge value and the lock value
(Column 3 lines 1 – 7);

computing a duplicate response value on said disk drive controller by performing
a duplicate secure hash algorithm (Column 5 line 55 – Column 6 line 31); and

comparing said response value to said duplicate response value (Column 5 line
55 – Column 6 line 31).

22. Claims 13 and 26 are rejected as applied above in rejecting claims 12 and 15.

Furthermore, Vicard teaches and describes unlocking the disk drive in accordance with the desired access mode indicated by the lock value if the response and duplicate response value match (Column 5 line 55 – Column 6 line 31).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

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may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy

May 30, 2006.



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